

GILL-GARRISON et al.
Appl. No. 09/771,933
November 21, 2003

REMARKS

Reconsideration is requested.

Claims 1-13 are pending. Claim 13 has been added and finds support throughout the specification. No new matter has been added.

In response to the species election requirement of October 21, 2003, applicants hereby elect (a) – genes that encode enzymes responsible for detoxification of xenobiotics in phase I metabolism (Species Election A) with traverse, and (d) – glutathione-S-transferase (Species Election B), also with traverse.

Furthermore, in the event the species requirements are maintained, applicants request rejoinder of all species in the event the generic claim (claim 1) is found allowable in relation to the elected species.

The Species Election A requirement is traversed and reconsideration and withdrawal of the Species Election A requirement are requested in view of any of the following comments.

The applicants respectfully submit that the Examiner has mischaracterized the present invention as relating to “genes”. Claim 1 of the instant application, from which all claims depend, relates to a computer assisted method of providing a **“personalized lifestyle advice plan”**. Said method involves the steps (i) to (vi) as recited in the claim. The claimed computer-assisted method relates to processing data relating to alleles of an individual and relating that data to information about those alleles in order to produce a personalized lifestyle advice plan. The present assignee is in fact presently commercially and successfully utilizing this technology – see www.sciona.com.

GILL-GARRISON et al.
Appl. No. 09/771,933
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The invention therefore does not relate to a "gene" as such, but instead is a way of utilizing data relating to alleles of genetic loci as a means to provide a useful and tangible result. As such, the applicants submit that claim 1 should be examined in respect of all steps (i) to (vi) generically.

The Examiner has failed to provide any basis for asserting that the Examiner's species (a) – (k) of Species Election A are separately patentable, or that the Examiner's species (a) – (g) of Species Election B are separately patentable, or that any of the species of Species Election A are separately patentable from any of the species of Species Election B. The Examiner should at least be required to provide some justification for the assertions with regard to the alleged separate patentability.

The Examiner's Species Election A requirement appears to be based on the applicants recitation of dependent claim 6, without consideration of the subject matter of the claimed invention. The claimed invention relates to a method which, as noted above, includes as one element of an embodiment, a reference to a first dataset which comprises information relating to two or more alleles of one or more genetic loci of the enumerated genes of dependent claim 6. The Examiner is requested to specify, with particularity, any basis for asserting that, within the context of the presently claimed invention, the species of Species Election A (or Species Election B) are separately patentable and/or that the species of Species Election A are separately patentable from the species of Species Election B.

The applicants respectfully request withdrawal of the species election requirement and examination of all the claimed subject matter.

GILL-GARRISON et al.
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The Species Election B requirement is traversed for the reasons set out above with regard to the Species Election A. Withdrawal of the Species Election B requirement and examination of all the claimed subject matter are requested for any of the reasons noted herein.

Beyond the above noted deficiencies of the Examiner's Species Election A requirement, the applicants note that the claims are not "directed" to "genetic loci" as such, as asserted by the Examiner, but to examining the alleles at genetic loci as part of a computer assisted method of providing a personalized lifestyle advice plan.

Additionally, the Species Election B requirement is potentially inconsistent with Species Requirement A. The species of Species Election B recited by the Examiner represent certain species which are within some of the broader categories of the Species Election A. Although applicants have elected a Species Election B species which is within the definition of the elected Species Election A species, there is no requirement by the Examiner of the same.

The Species Election B species set out by the Examiner are simply those recited in claim 8. As with the Examiner's unsupported and unjustified Species Election A being based on the enumerated components of dependent claim 6, the applicants submit that the Examiner's reliance on the recitation of claim 8 as the only basis for requiring a species election in Species Election B is inappropriate and the Species Election B requirement should be withdrawn.

The applicants further note that dependent claims 7 and 9, for example, recite each of the species of Species Election A and Species Election B, respectfully and, along with all the other pending claims, read on all the elected species. The Examiner's

GILL-GARRISON et al.
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species election requirement however is not believed to allow consideration of, for example, the methods of claims 7 and 9. That is, consideration and examination of these claims is believed to require examination of all of the species of Species Election A and Species Election B.

Withdrawal of the species election requirement and examination of all the claimed subject matter are requested.

Respectfully submitted,

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